

SUPPORT FOR THE AMENDMENTS

Claim 7 has been amended.

Claims 13-24 have been added.

The amendment to Claim 7 is supported by original Claims 1 and 7, as well as the specification at, for example, page 2, lines 18-22, page 8, lines 4-5, page 8, lines 19, and page 9, lines 7-8. New Claims 13-24 are supported by the original Claims 1-12 and, at least, page 2, lines 67 of the specification and the Examples.

No new matter is believed to have been entered by the present amendments.

REMARKS

Claims 1-24 are pending in the present application.

At the outset, Applicants wish to thank Examiner Fortuna for the helpful and courteous discussion with their undersigned representative on August 20, 2008. During this discussion several amendments and arguments to address the outstanding rejections over the prior art were discussed. The content of this discussion is reflected in and expanded upon in the following remarks. Reconsideration of the outstanding rejections is requested.

The rejections of: (a) Claims 1-3 under 35 U.S.C. §103(a) over JP 1-201253 (JP '253) in view of US 6,133,170 (Suenaga et al) and (b) Claims 4-6 under 35 U.S.C. §103(a) over JP 1-201253 (JP '253) in view of US 6,133,170 (Suenaga et al) and further in view of Koiso et al (US 5,975,074 or US 6,127,294), are respectfully traversed.

The Examiner alleges that JP '253, when viewed with Suenaga et al, disclose the claimed molded sheet. Applicants disagree noting that JP '253, even when combined with Suenaga et al, fail to disclose or suggest the fibrous material content, thickness, and/or breaking length limitations of the claimed invention.

With respect to the fibrous material, the claims require that the content of the “components other than the fibrous material” is “50% by weight or higher”. Thus, the fibrous material content cannot exceed 50%. The Examiner makes no attempt to show where this limitation is disclosed in JP '253. In fact, the only context where the amount of fibrous material is made is at page 6, last paragraph, of JP '253, but this is only in relation to the “suspension” prior to manufacturing the sheet-like heating member. Thus, the presently claimed invention is not obvious in view of JP '253 and Suenaga et al.

With respect to the thickness, the claims require that the thickness range from 0.08 to 1.2 mm. The Examiner cites page 7, third paragraph, of JP '253 as disclosing a sheet thickness ranging from 0.2 to 10 mm and alleges that Example 1 shows a sheet with a thickness of 1.2 mm. First, the Examiner's allegation related to Example 1 is incorrect as Example 1 discloses a sheet thickness of 5 mm, *not* 1.2 mm. Further, page 7, third paragraph, of JP '253 actually discloses that the preferable thickness is 2 to 8 mm, which would lead the artisan away from the claimed invention. Certainly this disclosure coupled with the aforementioned lack of a disclosure of the fibrous material content would not provide the artisan with any reasonable suggestion of the claimed invention. Thus, for this additional reason, the claimed invention is not obvious in view of JP '253 and Suenaga et al.

As for the breaking length, the claims require that the breaking length range from 100 to 4000 m. The Examiner alleges that breaking length is a recognized result effective variable and, therefore, alleges that the optimum value is a matter of routine optimization. Applicants submit that the Examiner has not established that the breaking length is a results effective variable and/or that the artisan would have any appreciation as to how the range may be altered to meet the claimed value without further differing from the claimed invention with respect to the fibrous material content and the thickness.

Applicants remind the Examiner that a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a

result- effective variable.). See also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (prior art suggested proportional balancing to achieve desired results in the formation of an alloy). The Examiner has failed to establish that breaking length is a variable which achieves a recognized result.

The Examiner cites Suenaga et al as evidencing that “breaking strength... can be obtained by the use of blended pulp, use of crosslinked fibers...” Applicants submit that Suenaga et al does not support the position that breaking length is a result effective variable. All Suenaga et al establishes is it is possible to alter breaking length. Moreover, Applicants refer to Comparative Example 5 as showing that breaking length is impacted by more than mere optimization as when an electrolyte is present in the amount in Comparative Example 5, the breaking length exceeds the upper threshold. Thus, for this additional reason, the claimed invention is not obvious in view of JP ‘253 and Suenaga et al.

The Koiso et al (US 5,975,074 or US 6,127,294) references are cited as allegedly disclosing that electrolytes can be added either to the slurry or to the intermediate web after it has been dried. Applicants make no statement with respect to this allegation and in no way acquiesce to the same. However, Applicants do submit that the Koiso et al (US 5,975,074 or US 6,127,294) references fail to compensate for the deficiencies in the combined disclosures of JP ‘253 and Suenaga et al above. As such, the claimed invention is not obvious in view of the combined disclosures of JP ‘253, Suenaga et al, and Kosio et al.

Applicants request withdrawal of these grounds of rejection.

The rejections of: (a) Claims 7, 9, and 10 under 35 U.S.C. §102(b) over JP 1-201253 (JP ‘253) and (b) Claims 8 and 11-12 under 35 U.S.C. §103(a) over JP 1-201253 (JP ‘253) in view of US 6,133,170 (Suenaga et al) and further in view of Koiso et al (US 5,975,074 or US 6,127,294), are obviated in part by amendment and respectfully traversed.

As discussed above, even when combined with Suenaga et al, JP ‘253 fails to disclose or suggest the fibrous material content, thickness, and/or breaking length limitations of the claimed invention. Since these limitations appear in Claim 7, Applicants submit that the claimed invention is not anticipated by or obvious in view of the combined disclosures of JP ‘253, Suenaga et al, and Kosio et al for the reasons given above.

With respect to the product-by-process claims, these claims are typically examined on the basis of the final product without consideration of the process by which they are produced. Indeed, with respect to the product-by-process limitation of the presently claimed invention, the courts have enunciated that: “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claims is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Without even addressing the process limitations, the Examiner is again reminded that, for the reasons given above, JP ‘253 fails to disclose or suggest the fibrous material content, thickness, and/or breaking length limitations of the claimed invention. Thus, JP ‘253 does not anticipate the product-by-process claims.

Applicants request withdrawal of these grounds of rejection.

Finally, Applicants respectfully request that the obviousness-type double patenting rejections of:

- (a) Claims 7-12 over Claims 1-4 and 11 of US 10/490,120; and
- (b) Claims 1-12 over Claims 12-23 of US 10/566,471,

be held in abeyance until an indication of allowable subject matter in the present application. If necessary, a terminal disclaimer will be filed at that time. Until such a time, Applicants make no statement with respect to the propriety of this ground of rejection.

The Examiner is reminded that MPEP §804 indicates that: "If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer."

Applicants submit that the application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully submitted,

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